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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte MIHAL LAZARIDIS and GARY P. MOUSSEAU

Appeal 2012-012222
Application 09/783,726
Technology Center 2400

Before: DAVID M. KOHUT, MICHAEL J. STRAUSS, and
LARRY J. HUME, *Administrative Patent Judges*.

STRAUSS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from a final rejection of claims 102-109, 111, 112 and 122-129. Claims 1-101, 110 and 113-121 have been cancelled previously. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

The claims are directed to a system and method for pushing information from a host system to a mobile data communication device. Claim 102, reproduced below, is illustrative of the claimed subject matter:

102. A method of pushing user data items from a messaging host system to a wireless mobile data communication device that is associated with a user having a mailbox at the messaging host system, the method comprising:

receiving notifications at a redirector component indicating receipt of user data items by the messaging host system, wherein the notifications are received in response to receipt of the user data items at the messaging host system;

processing the user data items by the redirector component to add address information associated with the wireless mobile data communication device; and

causing to continuously redirect the user data items to the wireless mobile data communication device over a wireless network without establishing a connection therewith.

REFERENCES

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Eggleston	US 5,764,899	Jun. 9, 1998
Murota	US 6,289,105 B1	Sep. 11, 2001

Software for Lotus cc:Mail Wireless, Communication Client Guide,
Motorola, 1995; hereinafter AirMobile Client.
AirMobile Wireless Software for Lotus cc:Mail, Communication Server
Guide, Motorola, 1995; hereinafter AirMobile Server.

REJECTIONS¹

The Examiner made the following rejections:

Claims 102-104, 106-109, 111, 112,² 122 and 124-129 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over AirMobile Client and Eggleston. Ans. 5.

Claims 105 and 123 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over AirMobile Server, AirMobile Client, Eggleston and Murota. Ans. 9.

APPELLANTS' CONTENTIONS

1. The AirMobile Server and AirMobile Client references “[do] not teach or suggest the claimed ‘push’ paradigm wherein a redirector component causes to continuously redirect the user data items from the messaging host system to the user's wireless mobile data communication device.” App. Br. 12.

2. AirMobile Client's disclosure of being “connected without maintaining a session” (AirMobile Client 30), leads to the conclusion that the reference “does not teach or suggest the feature of ‘causing to

¹ Based on Appellants' arguments, we will decide the appeal of claims 102-104, 106-109, 111, 122 and 124-129 based on claim 102 alone. *See* 37 C.F.R. § 41.37(c)(1)(vii).

² Although omitted from the listing of rejected claims, the rejection of claim 112 is detailed in the body of the rejection and acknowledged as rejected by Appellants. *See* App. Br. 8 and Ans. 9.

continuously redirect the user data items... without establishing a connection therewith' as claimed." App. Br. 13

3. Eggleston's "sessionless mode" provides a "virtual session connection" and, as such, is "[not] the same as or equivalent to the claimed feature reciting 'without establishing a connection herewith.'" App. Br. 20.

4. Expert Declarations submitted by Appellant in an interference proceeding in a related application support a conclusion that "the Eggleston/AirMobile communication system cannot reasonably be characterized as a communication system that can support continuous redirection of user data items as set forth in the claims on appeal." App. Br. 27.

ISSUES ON APPEAL

Based on Appellants' arguments in the Appeal Brief (App. Br. 9-27), the issue presented on appeal is whether the Examiner erred in concluding that the combination of AirMobile Client and Eggleston teaches or suggests a step of "causing to continuously redirect the user data items to the wireless mobile data communication device over a wireless network without establishing a connection therewith," as required by independent claim 102.

ANALYSIS

We have reviewed the Examiner's rejections in light of Appellants' arguments that the Examiner has erred.

We disagree with Appellants' conclusions as to all rejections. We adopt as our own (1) the findings and reasons set forth by the Examiner in the action from which this appeal is taken and (2) the reasons set forth by the Examiner in the Examiner's Answer in response to Appellants' Appeal

Brief. We concur with the conclusions reached by the Examiner. We highlight the following arguments for emphasis.

“Push Paradigm”

In connection with contention 1, to the extent that Appellants’ arguments are based on a “‘push’ paradigm” (App. Br. 10), the push feature is recited only in the preamble of the disputed claim and not otherwise referenced in the body of the claim.

“Generally . . . the preamble does not limit the claims.” *Allen Eng'g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1336, 1346 (Fed.Cir. 2002). Nonetheless, the preamble may be construed as limiting “if it recites essential structure or steps, or if it is ‘necessary to give life, meaning, and vitality’ to the claim.” *Catalina Mktg. Int'l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 808 (Fed.Cir.2002), quoting *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed.Cir.1999). A preamble is not regarded as limiting, however, “when the claim body describes a structurally complete invention such that deletion of the preamble phrase does not affect the structure or steps of the claimed invention.” *Catalina*, 289 F.3d at 809. Furthermore, the preamble has no separate limiting effect if, for example, “the preamble merely gives a descriptive name to the set of limitations in the body of the claim that completely set forth the invention.” *IMS Tech., Inc. v. Haas Automation, Inc.*, 206 F.3d 1422, 1434-35 (Fed.Cir.2000). *See also Am. Med. Sys., Inc. v. Biolitec, Inc.*, 618 F.3d 1354, 1359 (Fed. Cir. 2010.)

The preamble of claim 102 merely gives a descriptive name to the limitations set forth in the body of the claim that otherwise completely set forth the invention and does not limit the structure of the claimed device. We conclude that the preamble of claim 102 does not affect the steps of the

claimed invention and its recitations are not necessary to give meaning to the claim. Therefore, the preamble does not limit the claim, and we will not give it patentable weight.

For the reasons set forth *supra*, Appellants' arguments that the AirMobile Client disclosure describes a polling rather than a push system (App. Br. 12) are not persuasive of Examiner error.

Furthermore, to the extent that Appellants argue that the alleged failure of AirMobile Client to teach a "push paradigm" leads to a conclusion that the reference further fails to teach or suggest a step wherein "a redirector component causes to continuously redirect the user data items from the messaging host system to the user's wireless mobile data communication device," (*id*) we find such argument unpersuasive of Examiner error for several reasons. As an initial point, Appellants fail to detail why a push paradigm is required to meet the disputed claim limitations or why a polling paradigm (as alleged by Appellants to be taught by AirMobile Client) would exclude satisfying the disputed claim language. Nor do Appellants otherwise explain why the disputed claim language is not met by the applied AirMobile Client reference. Still further, to the extent that AirMobile Client discloses polling of an internal mail server to identify new email messages, such polling does not diminish or otherwise detract from the explicit disclosure that the retrieved messages are "pushed" out to clients. AirMobile Client 30. Therefore, we are not persuaded by Appellants' contention of Examiner error. We instead agree with the Examiner's analysis and conclusion that AirMobile Client teaches or suggests the disputed claim limitations. *See* Ans. 11.

Continuously Redirect Without Establishing a Connection

In connection with contention 2, Appellants argue that AirMobile Client's disclosure of being "connected without maintaining a session" (AirMobile Client 30), leads to a conclusion that the reference "does not teach or suggest the feature of 'causing to continuously redirect the user data items...without establishing a connection therewith' as claimed." App. Br. 13. The Examiner responds that AirMobile discloses a virtual wireless communication channel and Eggleston discloses "that messages are 'continuously redirected' across the virtual channel without 'establishing a connection', since the data is 'delivered in a sessionless mode.'" Ans. 12 citing to Eggleston, col. 7, ll. 10-11. Thus, the asserted deficiency of Airmobile Client is cured by Eggleston. Therefore Appellants' contention does not persuade us of error on the part of the Examiner because the Appellants are responding to the rejection by attacking the references separately, even though the rejection is based on the combined teachings of the references. Nonobviousness cannot be established by attacking the references individually when the rejection is predicated upon a combination of prior art disclosures. *See In re Merck & Co. Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

Therefore we find Appellants' contention 2 to be unpersuasive of Examiner error.

Equivalence of Sessionless Mode to Without Establishing a Connection³

In connection with contention 3 above, Appellants fail to provide persuasive argument or sufficient evidence supporting a conclusion that the Eggleston disclosure of delivering data in a sessionless mode would NOT have taught or at least suggested to one of ordinary skill the disputed limitation of without establishing a connection.

We note that, during examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1369, (Fed. Cir. 2004). In the present case, Appellants have failed to provide a definition of “without establishing a connection” or persuasive argument or sufficient evidence in support of why disclosure of a sessionless mode according to Eggleston would NOT teach or suggest such limitation. We therefore find the Examiner’s position that Eggleston’s sessionless mode teaches or suggests “without establishing a connection” to be reasonable and agree that the combination of AirMobile Client and Eggleston teaches or suggests the disputed limitation.

Furthermore, we agree with the Examiner that the disputed claim language does not “preclude the client and server from establishing a

³ Appellants raise two additional contentions that are not relevant to our analysis or decision including (i) similarities between the AirMobile and Eggleston disclosures, both having originated from Motorola (App. Br. 14-15); and (ii) the Examiner’s use, in addressing arguments previously asserted by Appellants, of the phrase “regardless of the availability of the wireless device” in association with the claim language “without establishing a connection therewith” (App. Br. 15 and Ans. 12-13.)

connection at any time.” Ans. 12. Thus, it is irrelevant if the virtual session of Airmobile and Eggleston is established prior to messages being identified and redirected so long as redirection is performed without *establishing* a connection whether or not a previously established connection has been used and/or is maintained.

Appellants further argue that Eggleston’s “sessionless mode” provides a “virtual session connection” and, as such, is “[not] the same as or equivalent to the claimed feature reciting ‘without establishing a connection herewith.’” App. Br. 20. We disagree. As explained *supra*, Appellants’ Specification has not provided a definition of a connection or what is meant by “without establishing a connection.” Absent any such definition or persuasive evidence to the contrary, the Examiner’s position that a disclosure of a “sessionless mode” meets the disputed step limitation of “without establishing a connection therewith” is reasonable. Furthermore, a reasonable interpretation of claim 102 does not require the complete omission of any and all previously established virtual connections, only that the step of causing a redirection not include establishing a connection. *See, e.g.*, Ans. 14. Therefore, we are not persuaded of Examiner error by this contention.

Expert Declarations

Appellants’ arguments based on the declarations of Andrew Seybold and Brad Karp are also not persuasive of Examiner error for several reasons. Initially and as previously indicated, we agree with the Examiner that the declarations are not persuasive of error because “[t]he current claims do not preclude establishment of a session at any time, only during redirection of

user data items.” Ans. 14. Furthermore, in addition to finding the Examiner’s substantive analysis and conclusion to be reasonable, we decline to substantively consider declarations prepared and submitted, not in connection with the instant application, but in connection with an interference conducted in a related application. Nor would it be appropriate to consider declarations submitted as part of an Information Disclosure Statement rather than pursuant to 37 CFR §1.132 such that the sufficiency of the declarations has not been formally reviewed or addressed by the present Examiner. For example, among potential deficiencies, the cited portions of the Seybold Declaration are based on observations of an actual operating AirMobile communication *system* rather than on the AirMobile or Eggleston *publication disclosures* that were relied upon by the Examiner. Furthermore, the declarations are directed to claims and language then pending in the cited interference, and not to claims subject to the instant appeal. While the claims of the two applications may utilize similar terminology, the claims have not been shown to be substantively identical. For at least these reasons we are unwilling to now entertain declarations on appeal that were not submitted as such to the Examiner.

CONCLUSIONS

On the record before us, we conclude that the Examiner did not err in rejecting independent claim 102 under 35 U.S.C. § 103(a) as being unpatentable over AirMobile Client and Eggleston or in rejecting claims 103, 104, 106-109, 111, 112, 122 and 124-129, not separately argued. Likewise, we conclude that the Examiner did not err in rejecting 105 and

Appeal 2012-012222
Application 09/783,726

123 under 35 U.S.C. § 103(a) as being unpatentable over AirMobile Server, AirMobile Client, Eggleston and Murota.

DECISION

The decision of the Examiner to reject claims 102-109, 111, 112 and 122-129 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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